United States Copyright Office
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February 22, 2013

Jess M. Collen
Collen IP, Intellectual Property Law, P.C.
The Holyoke-Manhattan Building
80 South Highland Avenue
Ossining, NY 10562

Re: Classic Bag ref. 115748
Classic Bag ref. 103208
Copyright Office Control No. 61-316-7669(C)

Dear Mr. Collen:

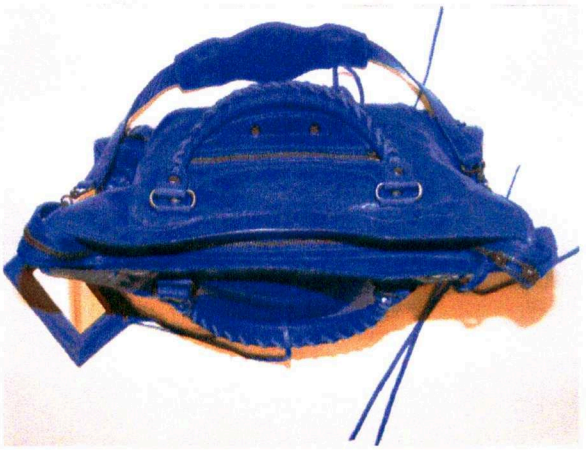
I am writing on behalf of the Copyright Office Review Board (the "Board") in response to your letter dated July 14, 2006, requesting reconsideration of a refusal to register works entitled Classic Bag ref. 115748 and Classic Bag ref. 103208 (the "subject bags") on behalf of your client, Balenciaga. We apologize for the long delay in resolving this case and providing you with the determination of the Board. Nevertheless, the Board has carefully examined the application, the deposit, and all correspondence in this case concerning this application and affirms the denial of registration of this work.

I. DESCRIPTION OF THE WORK

The subject bags consist of a blue or black leather exterior with floppy extensions on both sides of the main zipper compartment and handles featuring a spiraling ribbon design. The bags are also adorned with decorative top-stitching, bolts, rings, zippers, buckles, tassels extending from the main and side compartments, and straps.

Classic Bag ref. 115748





Classic Bag ref. 103208





II. ADMINISTRATIVE RECORD

A. Initial Application and the Office's Refusal to Register

On March 28, 2005, the Copyright Office (hereinafter the "Copyright Office" or the "Office") received two Form VA applications from you on behalf of your client, Balenciaga, to register two handbags as works of visual art. In a letter dated June 27, 2005, Visual Arts Section Examiner Sandra D. Ware refused registration of this work because the works are useful articles lacking any separable artistic or sculptural authorship necessary to support a copyright claim. Ms. Ware explained that the design of a useful article is considered copyrightable only to the extent that the design incorporates a pictorial, graphic, or sculptural feature that is physically or conceptually separable from the utilitarian aspects of the article. She further explained the differences between physical and conceptual separability, citing to the Office's practices from the *Compendium of Copyright Office Practices, Compendium II* (1984) (hereinafter "*Compendium II*"). She concluded that "[b]ecause all of the elements of the works you deposited are either related to the utilitarian aspects or function, or are subsumed within the overall shape, contour, or configuration of the articles," none of the features of the bags can be identified as separable. Letter from Ware to Collen (June 27, 2005), at 2.

B. First Request for Reconsideration

On September 27, 2005, the Office received your request to reconsider its refusal to register the visual art on the bags. You asserted that the design includes "elements which are purely artistic and which serve no useful function." Letter from Collen to Ware (Sept. 23, 2005), at 1.

In support of this assertion, you described aspects of the bags that you believe are conceptually separable from the useful article: the floppy extensions on both sides at the end of the main zipper compartment, the "ribbon design" on the handle, two buckles situated diagonally in the bottom right and left hand sides, "elongated ribbons," distinctive stitching and bolts. You also described the diagonal, wave, and scoop stitching elements. You maintain that the top stitching serves no function and that it was included for "purely artistic" purposes and that the combination of all these elements constitutes a copyrightable work of art. Letter from Collen to Examining Division of (Sept. 23, 2005) at 2.

C. Examining Division's Response to First Request for Reconsideration

In a letter dated February 8, 2006, Attorney Advisor Virginia Giroux-Rollow of the Examining Division replied that she had reviewed your client's work in light of the points raised in your request for reconsideration dated September 23, 2005, and determined that no copyright registration could be made "because they, useful articles, are handbags, functional in nature that do not contain any authorship that is **both** separable **and** copyrightable." Letter from Giroux-Rollow to Collen of (Feb. 8, 2006), at 1.

Ms. Giroux-Rollow then set forth the definition of a useful article under the Copyright Act and the extent to which such a work is copyrightable. She added that the fact that the handbags are made of leather and decorated with piping, stitching and ribbons in addition to buckles, bolts and rings does not contribute to the eligibility for registration. She then noted that section 101 of title 17 establishes the definition of a useful article as an "article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.'" She further explained that the Office uses the separability test detailed in *Compendium II,* § 505.03, which embodies the separability principles generally stated in *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 (D.C. Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). *Id.* at 2.

After analyzing the works in accordance with the policies and practices of the Office, Ms. Giroux-Rollow determined that the buckles, bolts and rings are uncopyrightable surface ornamentation. She further determined that the handles, straps, stitching and floppy extensions are either functional elements or "part of the overall styling, shape, contour, and configuration of the useful article itself, not physically or conceptually separable without destroying the basic shape of the work and, as such, not copyrightable." She did, however, find the leather ribbons or tassels to be conceptually separable, if not copyrightable, explaining that this element was a common and familiar design found in the public domain. Letter from Giroux-Rollow to Collen (Feb. 8, 2006), at 3.

Finally, she considered the combination and arrangement of the leather ribbons, stitching and hardware, concluding that the arrangement of these elements still failed to rise to the level of originality needed to support copyright registration. In addition, she noted that aesthetic appeal is not a relevant consideration in determining copyrightability, citing *Compendium II,* § 505.05 in support of this conclusion.

D. Second Request for Reconsideration

In a letter dated July 12, 2006, you again requested reconsideration of the Office's refusal to register the bags. You acknowledged that the bags are useful articles but asserted that there are several elements that are non-functional, separable and sufficiently original to support copyright registration. Specifically, you identified 1) the floppy extensions on both sides of the main zipper compartment, 2) the elongated ribbons [tassels] extending from the bags' main and side compartments, 3) the ribbon design on the handle, and 4) the buckles on the front of the bags. Letter from Collen to Board (July 12, 2006) at 1. You also asserted that the "unique combination" of those

elements exhibit "the minimum level of creativity required for copyright." *Id.* at 2.

In support of your position that the floppy ends of the zipper and the tassels are copyrightable, you cited *Gucci Timepieces America v. Yidah Watch Co.*, 1998 U.S. Dist. LEXIS 15972, *6 (C.D. Cal. 1998). *Id.* You argued that the extension of the zippers beyond the main compartment is not part of the useful feature of the handbag, but rather are distinguishing characteristics of the handbag. *Id.* In support of your position that the belt buckles are both conceptually separable and copyrightable, you cited *Kieselstein-Cord v. Accessories by Pearl, Inc.* 632 F.2d 989, 993 (2d Cir. 1980); and *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 441 (2d Cir. 1985). *Id.* at 3. Finally, in support of your compilation claim, you cited *Atari Games Corp. v. Oman*, 888 F.2d 878, 883 (D.C. Cir. 1989) for the Court's finding that "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection by the Register and in court." *Id.* at 3.

III. DECISION

After reviewing the applications and the arguments you presented, the Board reviewed the materials on a *de novo* basis and affirms the Examining Division's refusal to register the subject bags because although there are elements that are conceptually separable from the utilitarian aspects or functionality of the work, those elements do not contain a sufficient amount of original and creative authorship to support a copyright registration, either individually or in their selection and arrangement.

A. Useful Articles and Separability

A useful article is defined as having "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101 (definition of useful article). Additionally, any article that is normally a part of a useful article is considered a useful article. *Id.* Based on that statutory definition, the Balenciaga handbags are useful articles because they are mere forms within which end-users carry personal items. That is, despite superficial design on the handbags, the items' primary function is utilitarian. However, a design of a useful article may be entitled to copyright protection only if, and only to the extent, it contains pictorial, graphic or sculptural features that "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101 (definition of pictorial, graphic or sculptural works).

As a starting point, you do not dispute that the bags are useful articles, and the Board acknowledges that protection is being sought only for the separable elements and not for the overall shape of the useful article itself. Therefore, the Board must determine whether any pictorial, graphic or sculptural features of the bags are either physically or conceptually separable from the work's utilitarian function.

The Office uses the separability test, set forth in section 505.02 of the *Compendium II*, which states that:

> Registration of claims to copyright in three-dimensional useful articles can be considered only on the basis of separately identifiable pictorial, graphic, or sculptural features which are capable of independent existence apart from the shape of the useful article. Determination of separability may be made on either a conceptual or physical basis.

Physical Separability. Physical separability means that the subject pictorial, graphic, or sculptural features must be able to be separated from the useful article by ordinary means. As *Compendium II*, § 505.04 explains, "The physical separability test derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection." *See Mazer v. Stein*, 347 U.S. 201 (1954).

Physical separability, however, is not at issue. You do not put forth an argument that there are any physically separable pictorial, graphic, or sculptural features in the handbag designs nor does it appear from the deposit that any of the design elements are physically separable from the handbags. Thus, the Board must take the next step in the analysis and determine whether there are any pictorial, graphic, or sculptural elements that are conceptually separable.

Conceptual Separability. Conceptual separability exists when pictorial, graphic, or sculptural features are "independent of the shape of the useful article, *i.e.,* the artistic features can be imagined separately and independently from the useful article without destroying the basic shape of the useful article." *Compendium II,* § 505.03. For example, while a carving on the back of a chair cannot readily be physically separated from the chair, it can easily be conceptually separated because one could imagine the carving existing as a drawing. The chair, meanwhile, would still remain a useful article having retained its basic shape, even absent the carving.

However, just because a feature is not necessary to or dictated by the utilitarian concerns of an article does not mean that the feature is automatically conceptually separable. If removing such features would destroy the useful article's basic shape, namely because the features are an integral part of the overall shape or contour of the useful article, then the features would not qualify as conceptually separable.

Having examined the pictures of the two handbags, the Board concurs that the tassels, the spiral ribbon design on the handles, and the buckles are conceptually separable, as they can be visualized on paper and are independent of the shape of the useful article; thus, removal of those elements will not destroy the basic shape of the useful article. *See Compendium II*, § 505.03 (1984). The floppy extensions, however, are inextricably tied to the shape and function of the bags and, as such, are not conceptually separable. The Board will now consider the copyrightability of the separable elements.

B. *De Minimis* Authorship

In determining whether a useful article is entitled to registration, the Examining Division follows a two-part analysis. First a determination is made whether or not there are any design elements that are separable from the function of the useful article. If there is any separable work, then a determination is made as to whether such work rises to the level of authorship required by law. 17 U.S.C. § 102(a). As discussed above, the Board concludes that there are elements of the bags that are conceptually separable, namely, the elongated ribbons [tassels] extending from the bags' main and side compartments, the ribbon design on the handle, and the buckles on the front of the bags. However, the Board cannot agree, for the reasons discussed herein, with your conclusion that the ornamental elements meet the relatively low threshold of creativity necessary to sustain a copyright, either on their own merit or when considered in combination.

As you acknowledge, and the courts have held, originality has two components: 1) independent creation by the author and 2) a modicum of creativity. *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). The Board does not dispute that the overall designs in the works at issue *i.e.*, the Classic Bag ref. 115748 and Classic Bag ref. 103208 in their entirety, were independently authored by your client, Balenciaga; thus, the sole issue left for the Board to decide is whether the separable elements contain the necessary modicum of creativity to support a copyright registration.

In determining whether a work has a sufficient amount of original artistic authorship, the Board adheres to the standard set forth in *Feist*, where the Supreme Court held that only a modicum of creativity is necessary to support a copyright. 499 U.S. at 345. However, the *Feist* Court also ruled that some works (such as the work at issue in *Feist*) fail to meet the standard. The Court observed that "as a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity," *Id.* at 363, and that there can be no copyright in work in which "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. While "the standard of originality is low, . . . it does exist." *Id.* at 362.

The Office has long recognized this principle and has incorporated this standard into the Office's policies and practices. *See Compendium II*, § 202.02(a) ("[w]orks that lack even a certain minimum amount of original authorship are not copyrightable."). With respect to pictorial, graphic, and sculptural works, the class within which the subject bags, *see* 17 U.S.C. § 102(a)(5), the *Compendium II* states that a "certain minimal amount of original creative authorship is essential for registration in Class VA or in any other class." *Compendium II*, § 503.02(a). The *Compendium II* recognizes that it is the presence of creative expression that determines the copyrightability of a work, and that:

> [R]egistration cannot be based upon the simplicity of standard ornamentation . . . Similarly, it is not possible to copyright common geometric figures or shapes . . . [or] a simple combination of a few standard symbols such as a circle, a star, and a triangle, with minor linear or spatial variations.

Id. See also 37 C.F.R. § 202.1(a) ("familiar symbols or designs" are "not subject to copyright and applications for registration of such works cannot be entertained.").

The case law confirms these principles. *See, e.g., Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286-87 (3d Cir. 2004) (holding that the Copyright Office's views regarding the non-copyrightability of short phrases "merits deference" and "logically extends to part numbers"); *Atari Games Corp. v. Oman*, 979 F.2d 242, 247 (D.C. Cir. 1992) ("We do not in any way question the Register's position that simple geometric shapes and coloring alone are *per se* not copyrightable.") (internal quotation marks omitted); *Forstmann Woolen Co. v. J.W. Mays Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950) (label with words "Forstmann 100% Virgin Wool interwoven with standard *fleur-de-lis* could not support a copyright claim without original authorship); *Baile v. Fisher*, 258 F.2d 425 (D.C. Cir. 1958) (cardboard star with two folding flaps allowing star to stand for retail display not copyrightable work of art); *Magic Mktg., Inc. v. Mailing Servs. of Pittsburgh*, 634 F. Supp. 769 (W.D. Pa. 1986) (envelopes with black lines and words "gift check" or "priority message" did not contain minimal degree of creativity necessary for protection); *Tompkins Graphics, Inc. v. Zipatone, Inc.*, 222 U.S.P.Q. 49 (E.D. Pa. 1983) (collection of various geometric shapes not copyrightable).

Like in the works in the cases cited above, the three conceptually identified elements do not meet even the low standard for originality set forth in *Feist*. The buckles on the lower right and left sides of the bags are commonplace, standard buckles, with no additional ornamentation. Similarly, the tassels are mere strips of leather, which add only a slight variation to the handbag design but exhibit no creative or artistic aspect standing alone. Nor is the stitching on the handles anything more than a common, whip stitch, often used as a decorative design on handbags and in the fashion industry.[1]

The cases you have cited do not compel a different conclusion. The court in *Gucci* held that the letter "G" on the watch face in question was not a useful article, a conclusion that the Board would not dispute. In this respect, the Board agrees that the identified elements of the bags are analogous to the watch in the *Gucci* case, but only to the extent they are both works contain elements that are separable from the useful article. As noted in the Gucci case, the Copyright Office cancelled the registration of the work because, as with the handbags in this case, the separable elements "[did] not contain copyrightable authorship." *Gucci,* 1998 U.S. Dist. LEXIS 15972, at *3.

Similarly, in *Kieselstein-Cord*, the Second Circuit held that certain elements of a belt buckle were separable and sufficiently creative to support copyright protection. However, the court did not hold that all buckles are copyrightable. The Second Circuit stated that the belt buckles in *Kieselstein* should be "considered jewelry" that are distinct from both the belt buckles' functional frame and purpose. *Kieselstein*, 632 F.2d at 993. The Court explained that wearers of the buckles "used them as ornamentation for parts of the body other than the waist." *Id.* The same cannot be said for the

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[1] *See, e.g.*, Whip Stitch Waist Belt at http://weheartit.com/entry/23538866 and the purse at http://www.etsy.com/listing/91215255/leather-hand-tooled-brown-handbag-purse (last visited 2/13/2013).

buckles on the Balenciaga handbags; they cannot be viewed as jewelry. They are standard, unadorned buckles, albeit used for ornamentation, but lacking the sort of design features the Second Circuit found copyrightable.

Next, you cite *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985), a case in which the court invalidated registrations by the Copyright Office on four styles of mannequins on the grounds that the works failed to meet the separability test. In reaching this conclusion, the court categorized the works as utilitarian, and did not find any separable features that were not essential to the function. As noted above, the Compendium sets forth the Copyright Office's test for separability; and, under that analysis, the Board has found elements of the bags to be separable, if not sufficiently creative.

Finally, you cite *Atari* for the proposition that a combination of "simple shapes, when selected or combined in a manner indicating some ingenuity, have been accorded copyright protection by the Register and the courts." *Atari,* 888 F.2d at 883. The Board notes that in theory an author creating any work has an unlimited choice of alternatives. However, it is not the possibility of choices that determines copyrightability, but whether the resulting expression contains copyrightable authorship. A combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship. As the Ninth Circuit announced,

> It is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.

Satava v. Lowry, 323 F.3d 805, 811 (9th Cir. 2003). The *Atari* decision does not compel otherwise. Here the arrangement of the common and unprotectable elements identified on the handbags is not sufficiently creative to render it a copyrightable work of authorship. Placement of the tassels on the zippers, of the buckles in the corners, and the ornamental stitching on the handle is not an uncommon arrangement.

C. Artistic merit and commercial value

The Board notes your contention that the creator of the works, the Classic Bag ref. 115748 and Classic Bag ref. 103208, chose the stitching element for artistic, stylistic and aesthetic purposes. However, factors such as the bags' commercial success, the expense of creating them, the professional skills and expertise of the designer, or artistic recognition of the design are not relevant to the Board's determination of the bags' copyrightability. In evaluating whether a work meets the creativity threshold required by copyright law, it is necessary to examine the actual elements of the work, individually and in combination. In the case of a work of visual art, that review is limited to the actual

appearance of the work, and does not extend to its commercial success or aesthetic appeal. *See Paul Morelli Design, Inc. v. Tiffany and Co.*, 200 F. Supp. 2d 482, 488 (E.D. Pa 2002) ("Works may experience commercial success even without originality and works with originally may enjoy none whatsoever. Nothing has been presented to us showing any correlation between the two."); *see also Compendium II,* § 503.02(b) ("the requisite minimal amount of original sculptural authorship necessary for registration in Class Va does not depend upon the aesthetic merit, commercial appeal, or symbolic value of a work.").

IV. CONCLUSION

For the reasons stated herein, the Copyright Office Review Board affirms the refusal to register Classic Bag ref. 115748 and Classic Bag ref. 103208. This decision constitutes final agency action in this matter.

Sincerely,

Tanya M. Sandros
Deputy General Counsel
for the Review Board
United States Copyright Office